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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,501	08/08/2000	Hisanori Senba	NEC00P244-as	4533
7590 01/05/2005			EXAMINER	
McGinn & Gibb PC 8321 Old Courthouse Rd. Suite 200 Vienna, VA 22182-3817			BURD, KEVIN MICHAEL	
			ART UNIT	PAPER NUMBER
			2631	

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/634,501

Applicant(s)

SENBA, HISANORI

Examiner

Kevin M. Burd

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6, 8-10, 14-18, 20, 21, 23 and 26 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 11-13, 19, 22, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. This office action, in response to the amendment filed 9/21/2004, is a final office action.

### ***Response to Arguments***

2. The rejection of claim 21 is withdrawn.
3. Applicant's arguments filed 9/21/2004 have been fully considered but they are not persuasive. Applicant has added the new limitation of switching to the terminal mode in response to elapsing of a predetermined period of time in claims 1, 2, 7, 11-13, 19, 22, 24 and 25 and states this limitation is neither shown nor suggested by the reference. The examiner disagrees. As stated in the previous office action, the switching of modes takes place when a clock signal is detected. The circuit will attempt to switch from this contactless mode to a contact mode when a clock signal detection means detects the presence of a received clock signal. This detection will take some amount of time, which is known in the circuit. Therefore, the switching to the terminal mode is in response to the elapsing of a predetermined period of time and a clock signal being present. The rejections of these claims are maintained and stated below. Regarding claims 22, 24 and 25, the reset signal will re-initialize the device to one of the original stating modes, contact or contactless. When the original starting mode is the contact mode, the device will be reset to that mode. If the device is in contactless mode when a reset is triggered, the device will be switched. Claims 3-6, 8-10, 14-18, 20, 21, 23 and 26 are allowed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 7, 11-13, 19, 22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Thuringer et al (US 6,199,763).

Regarding claims 1, 11 and 12, Thuringer discloses a dual mode data carrier and circuit for operating in a contact bound mode (terminal mode) and a contactless mode (RF mode) (abstract). Figure 1 discloses a plurality of connection terminals for being supplied with data, clock and power signals. Column 1 discloses the contactless mode receives HF (high frequency) signals via a transmission coil. This coil is the antenna. The circuit communicates via a contactless mode when solely the contactless activation information is present and enables contact bound communication when solely contact bound information is present as stated in column 20, lines 53-60). The mode of the circuit is set to the contactless mode first and will attempt to switch from this contactless mode to a contact mode when a clock signal detection means detects the presence of a received clock signal and upon the detection of a received clock signal in a detection

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process, enabling the supply of contact activation information to be initiated (column 2, lines 3-13).

Regarding claims 2 and 13, the mode selecting circuit maintains a current mode until a new power supply potential is detected (column 18, line 62 to column 19, line 4). The previous supply potential will have ended.

Regarding claims 7 and 19, the power is received via a contact or from the transmitting coil as shown in figure 1 and column 9, line 55 to column 10, line 10).

Regarding claims 22, 24 and 25, the reset signal is shown in figure 1 and column 5, line 62 to column 6, line 18 and aids in switching the mode of the circuit.

### ***Allowable Subject Matter***

5. Claims 3-6, 8-10, 14-18, 20, 21, 23 and 26 are allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Burd whose telephone number is (571) 272-3008. The examiner can normally be reached on Monday - Thursday 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ghayour can be reached on (571) 272-3021. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin M. Burd  
1/3/2005

KEVIN BURD  
PRIMARY EXAMINER